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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/728,173

12/04/2003

Douglas Andrew Levin

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PATENT ADMINISTRATOR  
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EXAMINER

HEWITT II, CALVIN L

ART UNIT

PAPER NUMBER

3685

NOTIFICATION DATE

DELIVERY MODE

01/23/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/728,173	<b>Applicant(s)</b> LEVIN ET AL.	
	<b>Examiner</b> CALVIN L. HEWITT II	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 6-30-08.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/28/08, 4/23/08, 5/15/08, 5/19/08, 8/29/08, 10/31/08</u>     | 6) <input type="checkbox"/> Other: _____                          |



***Status of Claims***

1. Claims 2-5 and 28 have been examined.

***Response to Arguments/Amendments***

2. Applicant's arguments with respect to claims 2-5 and 28 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-5 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step(s) are:

- receiving a request message comprising a license identifier
- distributing the protectable content and the license identifier

Claim 5 is also rejected as it recites similar language.

Claims 3, 4, and 28 are also rejected as each depends from claim 2.

Claim 28 recites "transmitting a reply message concerning the authenticity of the license." However, claim 2, from which claim 28 depends, is directed to determining the authenticity of the license identifier, therefore it is unclear to one of ordinary skill how the license is authenticated when only the identifier is authenticated.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 2, 4, 5 and 28 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Tardo et al., U.S. Patent No. 6,557,105.

As per claims 2, 4, 5 and 28, Tardo et al. teach a method comprising:

- accessing a license profile associated with the protectable content, the license profile identifying attributes affecting at least one operation of the protectable content (column 6, lines 30-38; column 7, lines 22-40)
- accessing a content identifier representing the protectable content, wherein the protectable content corresponds to at least one of a software element, multimedia presentation, a video segment, an audio segment, a textual representation, a work of art, a visual representation, a technological, know-how, a business know-how, and a contract right- associated with a license (column 5, lines 3-14 and 25-40; column 6, lines 30-40)
- computing a license identifier based, at least in part, on the accessed license profile and the accessed content identifier, the computed license identifier comprising information concerning the license associated with the protectable content (signed encrypted license token 122) (column 5, lines 50-67)
- storing the license identifier (column 5, lines 45-56)
- transmitting the license identifier over a network; (column 7, lines 55-60)
- receiving a request message over a network to authenticate the license identifier (column 7, lines 40-45)

- comparing the received license identifier with a corresponding stored license identifier to authenticate the license identifier (column/line 7/64-8/48)
- transmitting a reply message concerning the authenticity of the license

Regarding the license identifier, it has been held that “[l]anguage that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation” (MPEP 2106 II C), therefore what the license is intended for (i.e. for subsequent distribution with the protectable content) will not distinguish the claims from the prior art.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-5 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tardo et al., U.S. Patent No. 6,557,105.

As per claims 2, 4, 5 and 28, Tardo et al. teach a method comprising:

- accessing a license profile associated with the protectable content, the license profile identifying attributes affecting at least one operation of the protectable content (column 6, lines 30-38; column 7, lines 22-40)
- accessing a content identifier representing the protectable content, wherein the protectable content corresponds to at least one of a software element, multimedia presentation, a video segment, an audio segment, a textual representation, a work of art, a visual representation, a technological, know-how, a business know-how, and a contract right- associated with a license (column 5, lines 3-14 and 25-40; column 6, lines 30-40)
- computing a license identifier based, at least in part, on the accessed license profile and the accessed content identifier, the computed license identifier comprising information concerning the license associated with the protectable content (signed encrypted license token 122) (column 5, lines 50-67)
- storing the license identifier (column 5, lines 45-56)
- transmitting the license identifier over a network; (column 7, lines 55-60)
- receiving a request message over a network to authenticate the license identifier (column 7, lines 40-45)

- comparing the received license identifier with a corresponding stored license identifier to authenticate the license identifier (column/line 7/64-8/48)
- transmitting a reply message concerning the authenticity of the license

Regarding the license identifier, it has been held that “[l]anguage that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation” (MPEP 2106 II C), therefore what the license is intended for (i.e. for subsequent distribution with the protectable content) will not distinguish the claims from the prior art.

As per claim 3, Tardo et al. is directed to enabling software options (column 4, lines 14-53) therefore, as open-source software is also software a predictable result (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)) would have been to apply the teachings of Tardo et al. to open source software (e.g. JVM, JAVA).

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

<http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685